

REMARKS

Claims 1-31 are pending in the present application.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. Specifically, in the Office Action of July 31, 2006, the Examiner rejected claim 31 under 35 U.S.C. 112, second paragraph as being indefinite and rejected claims 1-31 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,709,976 (hereinafter "Malhotra") in view of U.S. Patent No. 5,614,325 (hereinafter "Chartier").

It is respectfully submitted that the presently pending claims be examined and allowed.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claim 31 as not being clearly defined in light of claim 1. Claim 31 previously read "A media sheet as in claim 1, wherein the receiving layers are devoid of binder." The Examiner is alleging that the term binder is broad covering compounds/polymers that can also be discharge control agents. As claim 1 incorporates the use of a discharge control agent in the receiving layer, the Examiner has questioned the validity of the claim.

Claim 31 has been amended to read "A media sheet as in claim 1, wherein the receiving layers are devoid of a dedicated binder." Thus, any of the other components that are present for another purpose can act to bind the composition, as long as there is not a binder present that acts solely for that purpose. As now written, claim 31 is believed to be especially clear in that the receiving layer is devoid of compounds that act solely as binders. Withdrawal of this rejection is respectfully requested.

Rejections Under 35 U.S.C. § 103

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has

to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. Ultimately, the Examiner must show that the combination has proper motivation, provides all the elements of the present invention, and has a likelihood of success at providing the present invention. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

Malhotra discloses two distinct embodiments of its invention, an inkjet embodiment and an electrophotographic embodiment. See col. 1, lines 5-9. Malhotra teaches a coated paper having “hydrophobic barrier layer” and either “an image receiving” layer for “aqueous ink[s]” or an “image receiving” layer for “electrostatic toner compositions.” See col. 1, lines 9-27. It is worthy to note, that regardless of the application, Malhotra teaches a hydrophobic barrier layer. The hydrophobic barrier layer is defined exactly the same for both embodiments, “a hydrophobic barrier layer comprised of a water insoluble component and a water soluble or alcohol soluble anticurl agent, said hydrophobic barrier layer being present on both sides of the substrate....” See col. 1, lines 11-14, 21-24. The water insoluble component is defined as insoluble polymers, monomeric silanes, and other emulsions. As noted by the Examiner, for the electrophotographic embodiment, the image receiving layer comprises “(1) a polymeric binder, (2) an antistatic agent[,] (3) a lightfastness inducing agent, and (4) a pigment, or filler. See col. 5, lines 38-40. An optional biocide is added later in the specification. See col. 7, lines 20-21.

Chartier describes electrophotographic coated print media, but only describes single layer coatings (on both sides). See Abstract.

The Examiner has alleged that the combination of Malhotra and Chartier would lead one skilled in the art to the claimed invention. The Examiner has argued that Malhotra provides all the elements of the present claim set, except that Malhotra’s hydrophobic barrier layer, which the Examiner compares to the Applicant’s base layer, does not contain inorganic pigments or the discharge control agent. See Office Action, page 4. The Examiner then uses Chartier to provide the discharge control agent and inorganic pigment.

However, the combination of Malhotra and Chartier would not provide each and every element of the present invention, nor would it lead one skilled in the art to

the multi-layered coating system of the claimed invention. As a first matter, the claimed invention is not just a batch of various components, but individual layers with specific components in each layer. Thus, the relationship of what is in each layer, as well as the inter-layer relationship is key to the invention. Individual components cannot be mixed and matched as suggested by the Examiner. For example, the Examiner is using an electrostatic printing layer of Chartier (the layer where toner is received in Chartier) to provide components that are to be added the hydrophobic barrier layer of Malhotra. If anything, the single layer in Chartier is more analogous to the image receiving layer of Malhotra.

As the Examiner noted, Malhotra teaches a receiving layer containing a polymeric binder, an antistatic agent, a lightfastness inducing agent, a pigment, or filler, and an optional biocide. The Examiner also noted that Chartier teaches a receiving layer containing a binder, fillers, and an antistatic agent. Using this logic, at most, the combination of Malhotra and Chartier would provide a receiving layer having antistatic agents, binders, fillers, a lightfastness inducing agent, and an optional biocide. Thus, the combination would not render obvious the presently claimed invention, which requires that the base layer contain a discharge control agent and inorganic pigments.

Conversely, if the layer in Chartier were used to replace the base layer, the combination of references would destroy the function of the primary reference, Malhotra. Malhotra teaches that in each embodiment of its invention, the base layer contains an anticurling agent to provide "paper recording sheets . . . exhibit[ing] reduced curl." See col. 3, lines 46-49. If Malhotra's base layer were replaced with Chartier's receiving layer, the claimed function of Malhotra's invention would be destroyed, as there would be no anticurling agent. Further, this layer would likely not have the same hydrophobic properties as is required by Malhotra to be a "barrier layer."

Thus, as described above, using the single layer of Chartier to replace either layer of Malhotra would not be sufficient to render the claimed invention obvious. The only way to utilize Chartier in combination with Malhotra that would lead to the claimed invention would be to pick and choose known components from each of the references, and then use those references to reconstruct the claimed layers of the present invention, including their claimed relationship to one another and to the

substrate. This type of analysis amounts to impermissible hindsight. In other words, by mixing and matching the various layers in Malhotra and Chartier, elements are missing, the function of Malhotra is destroyed, etc. Alternatively, by choosing individual known ingredients from the two references and putting those together in multiple layers precisely as is presently claimed would require undue experimentation and amounts to hindsight analysis.

As a further note, there does not appear to be appropriate motivation to combine Malhotra with Chartier. The Examiner alleges that a person skilled in the art would combine the two references to take advantage of the feeding properties and to reduce electrostatic charges as outlined in Chartier. However, Malhotra already possesses an antistatic control agent in the receiving layer, as noted by the Examiner. If Malhotra already has an antistatic control agent, where is the motivation for a person skilled in the art to add another? Likewise, the Examiner alleges that Malhotra already possesses inorganic pigments in its receiving layer. If Malhotra already has inorganic pigments, where is the motivation for a person skilled in the art to add more in a different layer?

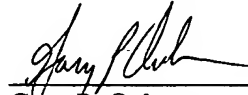
The Applicant recognizes that it is the combination of the two references that the Examiner is using to arrive at the claimed invention and not either reference individually. The above discussion is provided to show why the two references are not believed to be properly combinable, and that even if such a combination were made, the combination would still fail to provide each and every element of the present invention. Reconsideration of this rejection on these grounds is respectfully requested.

In view of the foregoing, Applicants believe that claims 1-31 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159, or the undersigned, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any
overpayment to Deposit Account No. 08-2025.

Dated this 31st day of October, 2006.

Respectfully submitted,



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